

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 12, and 14-19 are pending in this case. Claim 19 is new. Claims 12 and 17 have been amended by the present amendment. Claim 13 is cancelled without prejudice or disclaimer. Support for amended Claims 12 and 17, and new Claim 19 can be found, for example, in the original claims, drawings, and specification as filed.¹ No new matter has been added.

In the outstanding Office Action, Claims 12-18 were rejected under 35 U.S.C. § 103(a) as unpatentable over Tatebayashi et al. (U.S. Patent No. 6,859,535; hereinafter “Tatebayashi”) and further in view of Chan et al. (U.S. Patent No. 6,226,237; hereinafter “Chan”).

In response to the rejection of Claims 12-18 under 35 U.S.C. § 103(a) as unpatentable over Tatebayashi in view of Chan, Applicants amend independent Claim 12 to recite features of Claim 13. Applicants respectfully submit that amended independent Claim 12 recites novel features clearly not taught nor rendered obvious by the applied references.

Amended independent Claim 12 is directed to a general purpose computer including, *inter alia*:

...a control mechanism for supplying copyrighted data read from said external storage card to said reproducing mechanism upon successful cross-authentication by said cross-authentication mechanism,

wherein said power controller supplies power to said cross-authentication mechanism and said control mechanism even if power of said central processing unit is turned off.

¹ See original Claim 13, and page 39, line 18 to page 43, line 21.

Page 3 of the outstanding Office Action acknowledges that Tatebayashi fails to teach or suggest “a power controller that supplies power to said general-purpose computer, wherein said power controller supplies power to said decoding mechanism and said reproduction mechanism even if power of said central processing unit is turned off, and said loading mechanism is configured to read said decoded data without control of a central processing unit when said general-purpose computer is in an inactive state.” In an attempt to cure the deficiencies of Tatebayashi, the outstanding Office Action cites Chan. However, Chan also fails to teach or suggest the above feature.

Chan describes that if only a CD-ROM subsystem 106 is energized, then a state machine 202 exchanges electrical signals with a IDE-bus extension 129 via a IDE-signals multiplexer 244. If the computer subsystem 104 is not energized, the host IDE interface 242 electrically isolates an audio-interface IC 102 from a IDE bus 128 of the computer subsystem 104 to reduce, as much as possible, leakage current flowing from the CD-ROM subsystem 106 into the computer subsystem 104. Chan merely describes that when the computer subsystem 104 is not energized, current leakage is prevented from flowing from the CD-ROM subsystem 106 into the computer subsystem 104. Chan does not describe that the CPU 120 is powered off when the computer subsystem 104 is not energized. Further, Chan does not describe that a loading mechanism is configured to read decoded data without control of the CPU 120 when the computer subsystem 104 is in an inactive state (e.g. not energized).

Further, Chan fails to teach or suggest that a “power controller supplies power to said cross-authentication mechanism and said control mechanism even if power of said central processing unit is turned off,” as recited in Applicants’ amended independent Claim 12.

Chan does not describe that a power controller supplies power to a cross-authentication mechanism and a control mechanism (supplying copyrighted data read from an external storage card to reproducing mechanism upon successful cross-authentication by the

cross-authentication mechanism) even if power to a central processing unit is turned off. In fact, Chan does not describe a cross authentication mechanism at all. In Chan, a CD-ROM drive 138 reads a CD, but Chan does not describe cross authenticating an external storage card through a loading mechanism.

Page 4 of the outstanding Office Action asserts that Tatebayashi describes “a cross-authentication mechanism configured to cross authenticate said external storage card through said loading mechanism” and “*a control mechanism for supplying copyrighted data read from said external storage card to said reproducing mechanism* upon successful cross-authentication by said cross-authentication mechanism.” However, in Tatebayashi, the memory card reader 400, which reads an external storage card, is located in headphone stereo 401 and not in the personal computer 500. Thus, Tatebayashi does not describe that “*said power controller supplies power to* said cross-authentication mechanism and *said control mechanism* even if power of said central processing unit is turned off,” because the memory card reader 400 (i.e. control mechanism) is not located in the personal computer 500, where the power controller is located.

Page 4 of the outstanding Office Action also states that “it would have been obvious to the ordinary person skilled in the art at the time of the invention to employ the teachings of Chan to the music playing system of Tate in order to shut off the power to the idle personal computer while reading the data from the external medium by the content player subsystem, and having a display configured to display operating characteristics of the audio device while the computer is idle. This would have been obvious because the ordinary person skilled in the art would have been motivated to reduce the power consumed by the system.”

However, Applicants respectfully submit that it would not have been obvious for a person of ordinary skill in the art to modify the teachings from these references so as to arrive at Applicant’s claimed inventions. The position that these teachings *could* be modified to

arrive at the claimed inventions would be insufficient to establish a *prima facie* case of obviousness.² Furthermore, it is not clear how such modification could be achieved without a substantial reconstruction or redesign of the systems disclosed by these references.³ Further, the Supreme Court in *KSR International Co. v. Teleflex Inc.*, stated that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The court quoting *in re Kahn*⁴ stated that "[R]jections on obviousness cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

In rejecting a claim under 35 U.S.C. § 103(a), the USPTO must support its rejection by "substantial evidence" within the record,⁵ and by "clear and particular" evidence⁶ of a suggestion, teaching, or motivation to combine the teachings of different references. As discussed above, there is no substantial evidence, nor clear and particular evidence, within the record of motivation for modifying the Tatebayashi device by incorporating Chan's low power CD-ROM player. Without such motivation and absent improper hindsight reconstruction,⁷ a person of ordinary skill in the art would not be motivated to perform the proposed modification.

²See MPEP 2143.01 stating that the "fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness."

³ See *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (reversing an obviousness rejection where the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.")

⁴ 441 F.3d 977, 988 (Fed. Cir. 2006).

⁵ *In re Gartside*, 203 F3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000) (holding that, consistent with the Administrative Procedure Act at 5 USC 706(e), the CAFC reviews the Board's decisions based on factfindings, such as 35 U.S.C. § 103(a) rejections, using the 'substantial evidence' standard because these decisions are confined to the factual record compiled by the Board.)

⁶ *In re Dembiczak*, 175 F3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although 'the suggestion more often comes from the teachings of the pertinent references.' The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular." (emphasis added).

⁷ See MPEP 2141, stating, as one of the tenets of patent law applying to 35 USC 103, that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

Accordingly, Applicants' amended independent Claim 12 (and all claims depending thereon) is believed to be non-obvious and patentable over Tatebayashi and Chan.

Thus, Applicants respectfully request the rejection of Claims 12-18 under 35 U.S.C. § 103(a) as unpatentable over Tatebayashi in view of Chan be withdrawn.

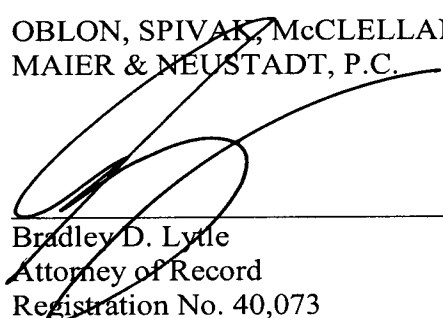
In order to vary the scope of protection recited in the claims, new Claim 19 is added. New Claim 19 is dependent on Claim 12, and is believed to be patentable for at least the reasons discussed above. New Claim 19 finds non-limiting support in the disclosure as originally filed, for example, at page 39, line 18 to page 43, line 21.

Therefore, the changes to the claims are not believed to raise a question of new matter.⁸

Consequently, in view of the present amendment, and in light of the above discussion, the pending claims as presented herewith are believed to be in condition for formal allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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⁸ See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."